RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANSULRICH REISACHER
and JUAN ANTONIO GONZALEZ GOMEZ

MAILED

JUN 01 2007

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal 2007-1205
Application 10/501,343
Technology Center 1700

Oral Hearing Held: May 8, 2007

Before EDWARD C. KIMLIN, CHUNG K. PAK, and PETER F. KRATZ, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

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The above-entitled matter came on for hearing on Tuesday, May 8, 2007, commencing at 1:27 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia, before Paula Lowery, Notary Public.

JUDGE KIMLIN: Go ahead.

MR. PITLICK: In this case what we have is a solid -- and I emphasize the word "solid" --

(A recess was taken.)

MR. PITLICK: The anticipation rejection relies on this Gonzales-Blanco patent, which is drawn to ink-jet inks and pigment preparations for the ink-jet inks, which we've argued clearly is going to liquids not solids.

The examiner has basically said, Because the reference doesn't say specifically whether it's liquid or solid, it could be solid.

The examiner also pointed to the fact that in column A, that Gonzalez-Blanco lists various percentage ranges, and for component C, which is water, it's as little as 10 percent. So the examiner says, Well, then, clearly it would read on solids.

We've argued that our preparations certainly don't exclude a certain amount of water, but still it can't be a sufficient amount of water to make it liquid.

I might also point out in addition to the various parts of Gonzalez-Blanco that we talked about in the brief, which indicates that it is a liquid, namely the use of word "suspensions" and things of that sort, the examples also make it clear that it's a liquid.

JUDGE KRATZ: What about column 8 about lines 26 to 32

where they talk about starting with nanocrystalline form of the pigment and mixing it with the dispersant and then dry crushing it as one option?

Wouldn't that suggest that at least at that stage you have a solid mixture of the dispersant with the pigment, which is really what your claim is to, is to the surfactant and the pigment?

MR. PITLICK: Perhaps.

JUDGE KRATZ: At least as an intermediate, because isn't it true that yours also is eventually going to be mixed with a liquid and become liquid?

MR. PITLICK: Right, right. You know, like I said -- perhaps. I mean, this is relatively broad, but that's the only disclosure that might suggest --

JUDGE KRATZ: That's about the best I could find in the reference.

MR. PITLICK: Yeah, and I certainly don't want to omit another argument we made. Again, we have the requirement of the anionic and the non-ionic.

While the reference certainly discloses you can use any kind, clearly there's no explicit suggestion to use specifically anionic and non-ionic, and they mention cationic also. Anybody who knows anything about surfactants would know you wouldn't combine an anionic and cationic and get a precipitate.

JUDGE KRATZ: But you're not claiming that.

MR. PITLICK: No, of course not. But my point is one scope of the argument would interpret these various disclosures of different kinds of dispersants or surfactants. Here you might be able to mix, let's say, two

non-ionics or two anionics or two cationics, but there's no disclosure or suggestion here to combine an anionic and a non-ionic.

JUDGE KRATZ: What about column 6, lines 15 through 24, where they talk about, "In addition to the dispersant used, the pigment preparation[s] according to the invention may contain further cationic, anionic, amphoteric and/or non-ionic surfactant compounds"?

And then goes on a little later to say, "If the dispersant used contains an ionic group, the[se] auxiliar[ies] should preferably be non-ionic or have the same ionic character[istics]." So it would suggest you could have a non-ionic mixed with another, you know, either positive -- cationic or a non-ionic dispersant.

MR. PITLICK: It does, but they're making a distinction between other surface active compounds in the specific materials that he discloses dispersants, even though, for example -- and I can't deny this -- it certainly suggests you can have presumably an anionic dispersant, which is ionic, and then you can add some non-ionic surfactant, which is somehow different other than the fact that it's different in terms of non-ionic versus ionic, but different in other ways.

Because, again, they're sort of lumping these differently. These additional surfactants are being lumped differently from the specific ones disclosed.

So at best, the reference says you certainly could not exclude a combination of a non-ionic and anionic, but that's the best that it has there.

JUDGE KRATZ: You're saying it doesn't have a description.

MR. PITLICK: Right. It's pretty specific in terms of the kinds of dispersant materials you can use. They have quite a long list.

Again, they have this other paragraph, which you referred to, so -- it doesn't teach against it, I suppose is what I would have to admit.

JUDGE KRATZ: Is there anything special about the ranges that you've chosen for these ingredients?

MR. PITLICK: I would imagine the applicants believe they get the best results with these percentages. I could, I suppose, segue into the obviousness type double patent rejection, the provisional one, because one of the differences is the amount of anionic which we've argued.

In these claims we have a maximum of 10 percent -- I don't want to confuse the two -- yeah, a maximum of 10 percent of the anionic in the other case, which I might say, just as an aside, I think that case is on appeal as well. I'm surprised I'm not arguing that case here today.

JUDGE KRATZ: Did you request that?

MR. PITLICK: I didn't request it, but I guess since we indicated it as a related appeal, I suppose I would have expected it.

JUDGE KRATZ: It's possible. I don't know that the examiner did the same in his answer, so I'm not sure how that got missed.

MR. PITLICK: Yeah, I don't recall. But at any rate, that's the main difference. One of the differences we argued was the difference in the percentages. They weren't overlapping.

The other case also has a particular limitation that -- well, this is the other case. Component B has to be a phosphoric or phosphonic ester -- this is the anionic surfactant in the other case -- if component C, which is the non-ionic, is not there at all because it could be zero.

So you can say they look to be somewhat similar, but they're not overlapping, and one doesn't suggest the other.

JUDGE KRATZ: They're right next to each other, as I recall, right? In other words --

MR. PITLICK: Yeah, one is 10 percent maximum, one has to be greater than 10 percent.

JUDGE KRATZ: Yes.

MR. PITLICK: Now, in terms of the 103 rejection, which I haven't responded to, the examiner is combining Nyssen with Gonzalez-Blanco. I might also add as well, Gonzalez-Blanco -- the main invention there was the nanometer, the particle size of the pigments for their ink-jet. Nyssen has micron size, basically in order of 1,000 greater.

But our primary argument has been that it would not combine Gonzalez-Blanco, which is a liquid and dealing with ink-jet inks, and Nyssen, which is dealing with coloring seeds.

Nyssen is solid like ours except that Nyssen only has -- it doesn't have a combination of anionic and non-ionic. It's got what they call a compound, which certainly includes non-ionic compounds, but not the combination.

JUDGE KRATZ: So basically, that's in addition to the argument you make for the independent claim. You're saying for that secondary reference application to those two --

MR. PITLICK: You wouldn't combine them because also the radical difference in particle size, but the main difference is you have a liquid and a solid. You wouldn't modify Gonzalez-Blanco, which is a primary reference.

You wouldn't take that solid and add it to the liquid and change it into a solid, but you wouldn't combine them also because of the particle

size difference.

That argument, I don't believe, is in the brief, but certainly it's there -- you don't need me to tell you that. I think it's quite clear.

JUDGE KRATZ: Are the issues substantially the same in the other appeal, I take it?

MR. PITLICK: I believe they are. I know the same references pretty much are there. I don't know if the examiner is using them exactly the same way.

JUDGE KIMLIN: Any further questions?

JUDGE KRATZ: No questions.

JUDGE KIMLIN: Mr. Pitlick, we have no further questions.

MR. PITLICK: Thank you.

JUDGE KIMLIN: Thank you for coming.

(Whereupon, the proceedings at 1:37 p.m. were concluded.)